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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,796	10/22/2001	Lesley O. Bond	5750-006	5617

23547 7590 07/16/2003

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EXAMINER

STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/047,796	BOND, LESLEY O.
	Examiner Daniel P Stephenson	Art Unit 3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 26 May 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-59 is/are pending in the application.
  - 4a) Of the above claim(s) 42-47 is/are withdrawn from consideration.
- 5) Claim(s) 48-55 is/are allowed.
- 6) Claim(s) 1-8, 14, 19, 22-28, 34, 39, 56, 58 and 59 is/are rejected.
- 7) Claim(s) 9-13, 15-18, 20, 21, 29-33, 35-38, 40, 41 and 57 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 April 2002 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4, 6-8, 14, 19, 22-24, 26-28, 34, 39, 56, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schellstede '173 in view of Brown. Schellstede '173 discloses an apparatus for perforating a tubular structure in which the piercing member is moved from a first position to a second piercing position through the casing, i.e. tubular structure. It is contained within a housing that has an inlet and is supported within a tubular structure. The piercing member contains a fluid flow path that is continuous with the flow path from the inlet of the housing. A control assembly controls when the piercing member moves from the first position to the second position and back. The first end of the housing is adapted to be connected to an elongate conduit which can move axially and rotatably within the casing to position the perforation apparatus. The perforating assembly further comprises a cylinder (256) in which the piercing member is slidably supported. The movement of the piercing member is driven by a pressurized fluid reservoir (19) acting on a piston (306) within the cylinder. The control assembly has a valve that controls the flow of pressurized fluid from the reservoir to the piston. There is a friction assembly (24) which is sized to frictionally engage the well as the housing is pushed through. There is also a pillow plate (350) located opposite the piecing member to cushion the apparatus when it is operated. Schellstede '173 does not show that there is a back-up plate which is connected to a piston, so that it can act in the opposite direction from the piercing member. Nor does it disclose that there is a ring shaped packer around the piercing member to

be in use when the back-up plate is activated through the piston controlled by a valve, wherein the piston is in fluid communication with a pressure reservoir. Nor does it disclose that the elongated conduit has a releasable lock assembly in which in one position it is fixed relative to the housing, and in a second position it is axially mobile relative to the housing.

It is notoriously conventional in the art of wells and wellbore to use a rotating drill string for attachment of a variety of well tools, and often these drill strings are installed with a j-slot in such a manner that they can be locked relative to the casing they are being lowered into. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a j-slot locking mechanism on the apparatus of Schellstede '173.

Brown discloses a well tool which is placed against the side wall of a casing. The well tool is moved to the wall through the use of pistons that are in communication with a pressure reservoir. Opposite the pistons is a ring shaped packer that insures a fluid seal around the well tool to be utilized. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the piston mechanism of Brown to the pillow plate of Schellstede '173. This would be done so that a larger range of casing widths would be able to be perforated, by using the pistons to travel a greater diameter wellbore. The seal would be placed there since when fluid is being placed into the wellbore it is best to have a sealed connection.

3. Claims 5 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schellstede '173 in view of Brown as applied to claims 1 and 22 above, and further in view of Sutliff. Schellstede '173 in view of Brown does not show that the friction member is a bowstring centralizer. Sutliff uses a bowstring centralizer in combination with a perforating assembly to center it within the casing. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to use the bowstring centralizer of Sutliff with the apparatus of Schellstede '173 in view of Brown. This would be done because it would decrease the mechanical parts and lower the chance of breakdown within the apparatus.

***Allowable Subject Matter***

4. Claims 48-55 are allowed.
5. Claims 9-13, 15-18, 20, 21, 29-33, 35-38, 40, 41, and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

It has been noted that the official notice taken in the previous office action and restated in the above rejection was not traversed. As such, the official notice taken now stands as prior art.

7. With regards to the applicants' arguments with regards to the use of Brown in conjunction with Schellstede, the examiner respectfully traverses the applicants' opinion. The applicant states on page 34 of the amendment that there is no suggestion that such a seal (as found in Brown) would be advantageous when a mechanical or structural type of piercing or punching member is used (as in Schellstede). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, on lines 52-64 of col. 9 of the Brown patent the usefulness of the seal is explained. It states that the seal is there to isolate a part [of the casing] thereof from the general borehole fluid environment and to anchor the tool body against displacements. Any time an injection is performed within a well, better performance is achieved when the injection site is fluidically isolated from the annular flow of the casing.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

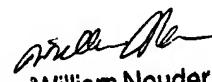
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.

David J. Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

DPS *WF*  
July 14, 2003



William Neuder  
Primary Examiner